

As a preliminary matter, it should be noted that a proper double patenting analysis involves a comparison of the claims, and not the disclosures, of the relevant patents. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082 (Fed. Cir. 1985). This is important to note because the Examiner did not indicate where in the claims of the '634 patent is recited a "first, isotactic block," which is an element of claims 26-46. In fact, the '634 patent claims are patentably distinguishable because they do not recite such an element. At least for this reason, claims 26-24 are patentably distinct from the claims of the '634 patent. In addition, the Examiner did not indicate where in the claims of the '634 patent is recited a catalyst in the form of "a hydride complex of a trivalent metal from the rare earth group" (having the indicated formula), as recited in claim 26 (and therefore as a limitation in dependent claims 27-46 as well). In fact, the '634 patent claims are patentably distinguishable because they do not recite such an element. At least for this additional reason, claims 26-24 are patentably distinct from the claims of the '634 patent. As a result, there is no proper basis for a double patenting rejection.

Even if, *in arguendo*, the Examiner intended to imply that the '634 patent claims form the basis for an obviousness rejection, then it was incorrect to equate that basis as sufficient for an obviousness-type double patenting rejection. *In re Bartfeld*, 925 F.2d 1450 (Fed. Cir. 1991) (stating that "double patenting depends entirely on what is *claimed* in [an] *issued* patent" and that a reference used for an obviousness rejection does not necessarily create an obviousness-type double patenting situation). As a result, the Examiner has not shown that claims 1-9 of the '634 patent are a sufficient and proper basis for an obviousness-type double patenting rejection. Accordingly, for at least the distinctions mentioned above, claims 26-46 are patentably distinct from the '634 patent claims. As a result, the double patenting rejection should be withdrawn.

In addition, as to the Examiner's conclusion (p. 3) that it would have been "obvious" for a skilled artisan to select and use the claimed hydride complex catalyst, such obviousness rejection should be withdrawn at least for the reasons discussed below.

First, the Examiner did not explain why a person of ordinary skill in the art would have found the selection and use of such element to be obvious in view of the '634 patent claims and disclosure. *Ex parte Clapp*, 277 U.S.P.Q. 972, 973 (B.P.A.I. 1985) (holding that an Examiner must support conclusion that claimed invention is directed to obvious subject matter by pointing to suggestion in the reference relied upon). Here, the Examiner did not (and cannot) point to any claim of the '634 patent rely, nor to any specific teaching in the '634 patent specification as evidence of a motivation to select and use (successfully) the claimed hydride complex catalyst of claims 26-46. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

Second, the Examiner admitted (p. 3) that the '634 patent claims in fact do not teach the use of a hydride complex catalyst as in claims 26-46. Also, the Examiner did not point to any teaching in the '634 patent regarding the production of a hydride complex catalyst. In particular, the '634 patent fails to provide any motivation to use such a catalyst, and does not provide any suggestion of a reasonable expectation of success in using such a catalyst in the process claimed in the above-referenced claims. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (a reasonable expectation of success must be found in the prior art). Moreover, the '634 is not a proper reference since it is not enabling as to the hydride complex and does not contain sufficient information regarding how to make and use the hydride complex. *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed.Cir.1989) ("In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus

or method."). As a result, the '634 patent does not teach or suggest this element of the claimed process.

Lastly, the Examiner fails to address the novel selection and use of "isotactic blocks" as recited in claims 26-46. *See Ex parte Clapp and In re Vaeck, supra.* Notably, the '634 patent is completely silent regarding isotactic blocks and such silence undercuts any attempt to characterize the use of isotactic blocks in the claimed method as obvious to a skilled artisan. This is especially true given the many forms of polyolefins that may be produced, such as isotactic, syndiotactic, atactic and isotactic-atactic (stereoblock). Each form can be quite different from the others in terms of both structure and physical properties (e.g., isotactic polypropylene contains principally repeating units with nearly identical configurations and is capable of forming a highly crystalline polymer with crystalline melting points and other desirable physical properties that are considerably different from the same polymer in an amorphous, or noncrystalline, state; *see* U.S. Patent No. 4,794,096 to Ewen, at col. 2, ll. 3-21). The Examiner did not (and cannot) point to any suggestion in the '634 patent that a skilled artisan would be motivated to select the manufacture of an isotactic block (nor to any disclosure the manufacture of such isotactic block) in novel methods as recited in claims 26-46.

Accordingly, the Applicants respectfully submit that the rejections of Claims 26-46 have been successfully traversed and should be withdrawn.

Conclusion

In view of the above amendments and remarks, each and every issue raised by the Examiner has been addressed and all of the rejections have been successfully traversed and/or mooted. No new matter has been introduced. Withdrawal of the present rejections and reconsideration is respectfully requested.

To the extent that specific pending claims have not been specifically discussed, these claims depend from one of the claims addressed above and are allowable over the cited prior art for at least the same reasons as discussed with respect to the parent claims. It is believed that the application is now in condition for allowance and prompt action by the Examiner to that end is respectfully requested.

Respectfully submitted,

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